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Serial No. 09/014,518

### REMARKS

Patent claims 1-9 and added claims 10-15 remain pending. In this Preliminary Amendment, claims 1 and 6 have been amended, and new claims 12-15 have been added. Patent Owner respectfully requests examination following entry of these amendments.

#### 1. Merged Proceedings

Patent Owner's attorneys apparently did not receive the original copy of the Decision to Merge Reexamination and Reissue Proceedings dated April 23, 1998, because it was not found after diligent search, and there have been no interruptions in the normal procedures for handling and docketing incoming mail from the PTO. When the undersigned attorney for Patent Owner telephoned Examiner Krynski on May 27, 1998 to inquire about the status of the petition, the Examiner was kind enough to fax a copy of the decision. The timeliness of a preliminary amendment was also discussed, and the Examiner said that if this preliminary amendment were filed via fax by May 28, 1998 it would be considered.

#### 2. Support for Amendments

The amendments are supported by the disclosure of the patent specification. Claims 1 and 6 have been amended to change the recited thickness range to 0.010-0.030 inches. New claims 12 and 13 mirror claims 1 and 6, respectively, but recite a thickness range of 0.030-0.060 inches. Similarly, new claims 14 and 15 mirror these claims but recite a thickness range of 0.015-0.040 inches.

In col. 2, line 30-37 of the specification, it is disclosed that the sheet may have a thickness in the range of 0.008-0.060 inches, and that in an exemplary embodiment the sheet has a thickness of approximately 0.010 inches. In col. 4, lines 6-15, a preferred thickness range of 0.008-0.030 inches is disclosed.

The history of the patent has some bearing on the support for these amendments. Subsequent to the filing of the original patent application (serial No. 07/994,665), which

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disclosed (and claimed) only the range of 0.008-0.030 inches, the inventor discovered that sheets having other, somewhat greater thicknesses would also be suitable. Thus, a CIP application (serial No. 08/259,006) was filed that disclosed (and claimed) the expanded range of 0.008-0.060 inches. It was later discovered during litigation involving the patent that, after the filing date of the parent application but more than one year before the filing date of the CIP, the assignee company had sold a product having a thickness in the range of 0.008-0.030 inches and otherwise believed to have been within the scope of the claims. As the inventor discusses in the reissue declaration, this fact went unrecognized as a prior art event relevant to the patentability of the claims and, as a result, was unintentionally not disclosed to the PTO. Patent Owner now desires to amend the patent to avoid any preclusive prior art effect of these sales. Thus, the reissue application, as filed, presented claims narrowing the broad thickness range to 0.008-0.030 inches. The prior sales by the assignee company do not anticipate such claims because such claims are entitled to the benefit of the filing date of the parent application. Similarly, the prior sales by the assignee company do not anticipate the claims reciting the extended thickness range of 0.030-0.060 inches because the product that was sold did not have a thickness within this range.

Although the applicant could have chosen to separately disclose and claim in the CIP application the original thickness range of 0.008-0.030 inches and the extended thickness range of 0.030-0.060 inches, the applicant chose the more straightforward alternative of disclosing and claiming the overall broad range of 0.008-0.060 inches. It is clear that the disclosure of the two ranges as 0.008-0.030 and 0.008-0.060 is equivalent to disclosure of the ranges of 0.008-0.030 and 0.030-0.060. In this reissue and reexamination proceeding, Patent Owner seeks, in effect, to split the claim that recited the broad range into two claims, each reciting a narrower range. In other words, since the extension portion of the range from 0.030 to 0.060 inches was added in the CIP, Patent Owner believes that this range could have been separately claimed in the CIP, as Patent Owner now seeks to do.

Also, although the specification discloses the thickness sub-range of 0.008-0.030 within the broader range of 0.008-0.060 inches, it is evident that a sheet having other

thicknesses within the broader range would be equally suitable and would provide equally unexpected results over the prior art. For example, a sheet having a thickness of 0.010 inches was disclosed as a specific example. Thus, Patent Owner believes the disclosure in the specification supports claims reciting a thickness range of 0.010-0.030 inches. See MPEP 2163.05(c) citing *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) (where ranges described in original specification included "25%- 60%" and specific examples of "36%" and "50%", a claim limitation to "between 35% and 60%" was held to meet the description requirement). Indeed, Patent Owner believes the disclosure in the specification supports claims reciting other thickness ranges subsumed by the broader range, such as the range of 0.015-0.040 inches recited in claims 14 and 15.

### 3. Patentability of the Claims Over the Prior Art

As set forth in the Supplemental Information Disclosure Statement dated May 8, 1998, Patent Owner believes that the Counter Maid product was about 0.008-0.0085 inches in thickness. In the Rule 132 declarations filed with reissue application relating to the commercial success of the invention, the prior art Counter Maid product was described as being too thin and flimsy. By reciting a lower bound for the thickness range of 0.010 in certain claims and 0.030 in others, the amended claims are directed to cutting mat that overcomes this problem. The difference in thickness between these lower bounds and the thickness of the Counter Maid product is more significant than one might expect. Scientists and plastics engineers have long known that the perceived stiffness of a plastic sheet varies with approximately the cube of its thickness. Patent Owner can readily provide a Rule 132 declaration or other evidence to this effect if requested by the Examiner. In other words, most people are surprised to learn, for example, that doubling the thickness of a sheet increases its perceived stiffness by about eight times ( $2^3=8$ ). In accordance with this principle, the difference of about two mils between the prior 8-8½ mil Counter Maid cutting sheet and the 10 mil lower bound recited in certain claims is more significant than one might expect. A two mil increase in the thickness of an eight mil sheet is an increase of 25%, resulting in a 63% increase in perceived stiffness ( $.63^3=.25$ ). The claimed cutting

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sheet, even in embodiments at the lower end of the recited thickness ranges, is considerably stiffer than the Counter Maid sheet and thus capable of supporting a surprisingly heavier load. Patent Owner respectfully urges the Examiner to take this effect into account in assessing the patentability of the amended claims.

#### 4. Conclusion

In view of the foregoing, Patent Owner believes all claims are supported by the specification and allowable over the prior art. Patent Owner respectfully solicits early examination and allowance of the application. This amendment is filed in duplicate for entry in both the reissue and reexamination files.

Respectfully submitted,

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